

**Notice of Allowability**

Application No.

09/868,515

Applicant(s)

SCHELBERGER ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to August 01, 2005.
2. ☒ The allowed claim(s) is/are 12-23, 27, and 31-38 (now renumbered to 1-21).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

*520 10/17/05*  
S. Anna Jiang, Ph.D.  
Primary Examiner,  
Art Unit 1617

**DETAILED ACTION**

This Office Action is in response to Applicant's amendment and response filed on August 01, 2005 wherein claims 24-25 are cancelled and claim 12 has been amended. Claims 1-11 are cancelled previously.

Currently, claims 12-23 and 26-38 are pending in this application.

Note that this application is a 371 of PCT/EP99/09803 filed December 11, 1999 which claims foreign priority to Germany 198589115 under 35 U.S.C. 119(a)-(d). The copy of certified copy of the priority has been filed with the instant Application. It is noted that Germany Application 198589115 is in Germany; no translation of said Germany application into English has been provided.

The Examiner's Amendment is set forth in next page.

***Examiner's Amendment***

An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the Issue Fee.

Authorization for this Examiner's Amendment was given in a telephone interview with Mr. Jason D. Voight on October 17, 2005.

The application has been amended as follows:

- Insert the following on page 1 of the instant **specification**, just below the title:

"This application is a 371 of PCT/EP99/09803 filed December 11, 1999 which claims foreign priority to Germany 198589115 under 35 U.S.C. 119(a)-(d), filed December 19, 1998."

The **Claims** have been amended as follows:

- Canceling claims 26, 28-30.

The **Abstract** has been amended as follows (see attachment):

- Deleting the compound Id.
- Deleting the description of the substituents of Formula II.

***Reasons For Allowance***

Claims 12-23, 27, and 31-38 are examined on the merits herein.

The claimed fungicidal mixture composition comprising a) a morpholine or piperidine compound herein, and b) a compound of formula (II) in a synergistically effective amount is not seen to be taught or fairly suggested by the prior art, as discussed below.

Applicant's amendment filed August 01, 2005 wherein the compound (id) has been removed from the claims, with respect to the rejection of claims 12-23 and 26-38 made under 35 U.S.C. 112 first paragraph for lack of written description for the compound (Id) herein of record stated in the Office Action dated April 1, 2005 have been fully considered and found persuasive to overcome the rejection since the compound (Id) has been removed from the claims. Therefore, the said rejection is withdrawn.

Applicant's amendment wherein the compound (id) has been removed from the claims filed August 01, 2005 with respect to the rejection of claims 12-23 and 26-38 made under 35 U.S.C. 112 first paragraph for lack of scope of enablement for the instant combination of active agents, compound (Id) and a compound of formula (II) of record stated in the Office Action dated April 1, 2005 have been fully considered and found persuasive to remove the rejection since the compound (Id) has been removed from the claims.

Applicant's remarks filed August 01, 2005 and June 10, 2004, and the factual evidence in the declaration of Dr. Eberhard Ammermann (submitted January 29, 2002) and specification, have been considered and are sufficient to overcome the rejection of claims 12-23 made under 35 U.S.C. 112, first paragraph, for lack of scope of enablement for a) Compound Ia; Ib; or Ic in combination with b) a compound of formula (II), in "a synergistically effective amount", of record in the previous Office Action April 1, 2005, since, first, as taught in the specification at page 16 and the declaration, Colby formula is known to be used to determine whether a combination of two plant protection agents exhibits synergistic effects,

i.e., the degree of action found  $> "E" \Rightarrow$  synergism, whereas degree of action found  $< "E" \Rightarrow$  no synergism, as illustrated in the declaration.

The testing results of Table 2 of the specification for the combinations in the specific amounts:

Ia and II.79; Ib and II.79; Ic and II.79 (Compound II.79 in Table at page 8), all show that the observed efficacy found greater than the calculated efficacy "E". Thus, these combinations are deemed to exhibit synergistic effects.

Moreover, the testing results of the table of the declaration at page 4 for the combinations in the specific amounts:

Ia and IIa; Ib and IIa; Ic and IIa (the structure of Compound IIa shown in the declaration at page 2), all show that the observed efficacy found greater than the calculated efficacy "E". Thus, these combinations are deemed to exhibit synergistic effects.

Second, the tested compounds Ia; Ib; Ic are seen to be a representative number of the instant compounds in a) of claim 12. The tested particular compounds of formula (II), II.79 and IIa are also seen to be a representative of the instant compounds of formula (II), in claim 12, since all instant compounds of formula (II) in claim 12 are deemed to be structurally close related or structurally similar compounds having the critical core structure of formula (II). Thus, one of ordinary skill in the art would have reasonably expected and predicted that the particular compound II.79 and IIa and the rest of instant compounds of b) in the claims, would have same or substantially similar synergistic fungicidal effects when combining with the compound of a), based on the reasonable expectation that structurally similar species usually have similar properties. See, e.g., Dillon, 919 F.2d at 693, 696, 16 USPQ2d at 1901, 1904. See also Deuel, 51 F.3d at 1558, 34 USPQ2d at 1214, as noted in MPEP 2144.

Therefore, the factual evidence in the specification and declaration is seen to provide sufficient support and enablement for the claimed combinations in “a synergistically effective amount”. Thus, the skilled artisan would not have to exercise “undue experimentation” to practice in the claimed composition.

Applicant's remarks filed August 01, 2005 and June 10, 2004, and the factual evidence in the declaration of Dr. Eberhard Ammermann (submitted January 29, 2002) and specification with respect to the rejection of claims 12-38 made under 35 U.S.C. 103(a) as being unpatentable over Schwalge et al. (WO 97/06681, of record) and Kasahara et al. (WO 96/19442, of record) of record in the previous Office Action April 1, 2005 have been considered and found persuasive to remove this rejection,

since, as discussed above, the unexpected synergistic effects of the claimed combination have been considered and found sufficient to rebut the prima facie case of obviousness.

Therefore, the cited prior art are not deemed to render the instant claimed compositions obvious to one of ordinary skill in the art. Therefore, the said rejection is withdrawn.

Accordingly, Applicant's amendment submitted August 01, 2005 in accompanying Examiner's Amendment set forth above are sufficient to remove all rejections made in the prior Office Action as discussed above and place the application in condition for allowance.

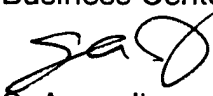
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner S. A. Jiang whose telephone number is 571.272.0627. The examiner can normally be reached on 9 am -5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571.272.0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Anna Jiang, Ph.D.  
Primary Examiner,  
Art Unit 1617  
September 17, 2005